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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,738	07/23/2001	Tomohiro Uchida	01436/LH	2686

7590 09/08/2004

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EXAMINER
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LE, VU

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/910,738

**Applicant(s)**

UCHIDA ET AL.

**Examiner**

Vu Le

**Art Unit**

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Bacus et al., US 6,226,392.

Re claim 1, Bacus et al discloses an imaging apparatus for a microscope (figs. 4A-4B, 5) comprising:

an imaging section which picks up an observation image of a sample formed in a microscope body (126, fig. 4B)); an imaging apparatus body having the imaging section (14, fig. 5); a display section which displays image data corresponding to the observation image picked up by the imaging section (22, fig. 5); and an operation section which performs operation of the imaging section (12,122,124, figs. 4A-4B, note: the computer 12 communicates through the system bus to the I/O controller and camera controller 124 to in effect control the camera sensor 126), wherein the imaging apparatus body and the display section are separate from each other (fig. 5, note: it can be seen that the camera subsystem 14 and the display section 22 are separate from each other).

Re claim 2, the imaging apparatus for a microscope according to claim 1, wherein the operation section is attached to the display section, and an angle of the display section to the operation section is adjustable (fig. 5, note: it can be seen that the computer controller 12 is also attached to the display section 22. It is inherent that the display 22 is adjustable relative to the computer 12).

Re claim 3, the imaging apparatus for a microscope according to claim 1, further comprising:

a storage section which stores image data corresponding to the observation image picked up by the imaging section (col. 9, lines 55-64), wherein the display section displays the image data stored in the storage section (col. 8, lines 58-62, col. 9, lines 12-17), the operation section which designates a display magnification of the image data stored in the storage section, in accordance with a designation made by the operation section (col. 10, lines 37-66), a partial area of the image data is displayed on the display section, enlarged at the display magnification, and an attachable and detachable recording medium for recording entire of the image data stored in the storage section (col. 9, line 54 to col. 10, line 66, note: in Bacus, "micro" images are characterized as "partial" image data, "tiled" images are characterized as "enlarged" display due to magnification increase, and hard disk storage for archival purposes is indicative that recording medium for recording image data can be attachable/detachable).

Re claim 4, the imaging apparatus for a microscope according to claim 3, wherein the partial area displayed and enlarged is a center part of the image data. In Bacus, (figs. 14, 14A 1-2, col. 12, lines 5-22) displaying partial area (30) and enlarging it (fig. 14a) are disclosed. There is no indication that the selected area for display is a

center part of the image data as claimed. However, this feature is inherent in view of Bacus because Bacus allows selection of any part of the image data to be displayed.

Re claim 5, the imaging apparatus for a microscope according to claim 3, wherein the operation section instructs position adjustment in the image data of the area enlarged and displayed, and the control section moves the area enlarged and displayed, within the image data, in accordance with an instruction made by the operation section (col. 9, line 18 to col. 10, line 66, also fig. 9).

Re claim 6, the imaging apparatus for a microscope according to claim 5, wherein the control section displays an index indicating the predetermined area, on the display section (figs. 1-3, col. 10, lines 32-45, note: in Bacus, the micro images as defined and displayed in fig. 2 shows an indexing scheme to prevent image overlapping, interference, etc... so that extensive image processing is avoided. Although the term "index" is not used per se, the functionality of the displayed micro images is in effect an indexing scheme for the "tiling" operation to generate higher magnification image).

Re claim 7, the imaging apparatus for a microscope according to claim 3, further comprising a recording medium which records at least a part of the image data stored in the storage section (fig. 4A, col. 9, lines 55-64).

Re claim 8, the imaging apparatus for a microscope according to claim 7, wherein the control section reads at least one image recorded on the recording medium and displays the image on the display section, minified in a list. This claim is rejected in reference to claim 6 above. Also see col. 10, 37-45 and fig. 2. Note: the micro images as defined in Bacus is in effect, a list of "minified" images.

Re claim 9, the imaging apparatus for a microscope according to claim 3, wherein the operation section sets the plurality of predetermined areas within the image area, and the control section displays images of the predetermined areas, at the display

magnification, in a list, on the display section (col. 10, 37-45 and fig. 2, see also col. 7, lines 19-50, col. 9, lines 3-17, note: in Bacus, the micro images are characterized as a plurality of predetermined areas within the image area; fig. 2 illustrates a listing of these micro images 24 displayed and also selected region(s) for displayed at specified magnification).

Re claim 10, the imaging apparatus for a microscope according to claim 1, wherein the operation section is integrated with one of the imaging apparatus body and the display section (fig. 5 shows an integrated microscopic imaging system, the operation section is served by 12, the imaging apparatus body is served by 14, and the display section is served by 22).

Re claim 11, the imaging apparatus for a microscope according to claim 1, wherein the operation section is separate from the imaging apparatus body and the display section (fig. 5 shows the operation section 12, the imaging apparatus body 14 and the display section 22 are separate from each other).

Re claim 12, the apparatus according to claim 1, wherein the operation section is attachable to and detachable from one of the imaging apparatus body and the display section (fig. 5, note: since the operation section 12 is a computer system, it is inherent that it can be attachable and detachable from the imaging apparatus body and the display section).

Re claim 13, the imaging apparatus for a microscope according to claim 1, wherein the operation section transmits contents of inputted operation by an electric signal to the imaging apparatus body (fig. 5, claim 13 is inherent in view of the figure. Communication between the operation section 12 and the imaging apparatus body 14 is via an electric signal).

Re claim 14, the imaging apparatus for a microscope according to claim 1, wherein the operation section transmits contents of inputted operation by an electric signal to the display section (fig. 5, claim 14 is inherent in view of the figure. Communication between the operation section 12 and the display section 22 is via an electric signal).

Re claim 15, the claim have been analyzed and rejected in view of claims 1 and 3 above.

Re claim 16, see claim 4 above.

Re claim 17, see claim 5 above.

Re claim 18, see claim 7 above.

Re claim 19, see claim 6 above.

Re claim 20, see claim 8 above.

Re claim 21, see claim 9 above.

### ***Drawings***

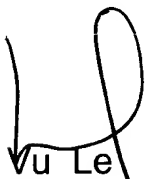
3. Figure 33 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Contact**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Le whose telephone number is 703-308-6613. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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